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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91208967
Party	Plaintiff Express, LLC
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Submission	Motion to Strike
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Date	04/02/2013
Attachments	motion to strike.PDF (16 pages)(640249 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of Application Serial No. 85/627,524
Published in the *Official Gazette* on September 25, 2012
Mark: EXP

Express, LLC,	:	Opposition No. 91208967
Opposer,	:	
v.	:	
EXP613, LLC,	:	
Applicant.	:	

OPPOSER'S MOTION TO STRIKE APPLICANT'S ANSWER

Pursuant to Rule 12(f) of the Federal Rules of Civil Procedure and Section 506 of the TBMP, opposer Express, LLC ("Opposer") hereby moves the Board for an order striking argumentative responses contained in the answer filed by applicant EXP613, LLC ("Applicant") to Opposer's notice of opposition, on the ground that these responses are inappropriate and immaterial under the Federal Rules and the TBMP. Opposer also moves the Board for an order striking references to Applicant's status as an "intellectual property holding company" on the ground that these references are also immaterial to the claims and defenses in this proceeding.

ARGUMENT

I. APPLICANT'S ARGUMENTATIVE RESPONSES IN ITS ANSWER CONTRAVENE PLEADING RULES AND SHOULD BE STRICKEN

Applicant's answer contains immaterial, argumentative responses that violate the requirements of the Federal Rules and the TBMP regarding the substance of an answer. Under

the TBMP, an applicant shall state, in its answer to a notice of opposition, "in short and plain terms the respondent's defenses to each claim asserted and shall admit or deny the averments upon which the petitioner relies." TBMP § 311.02; 37 C.F.R. § 2.106(b)(1); 37 C.F.R. § 2.114(b)(1). Furthermore, a "defendant should not argue the merits of the allegations in a complaint but rather should state, as to each of the allegations contained in the complaint, that the allegation is either admitted or denied." TBMP § 311.02(a).

In its answer to Express' notice of opposition, EXP613 includes throughout its pleading numerous argumentative responses and lengthy asides in addition to its admissions to and denials of the substantive facts and claims of Opposer, in direct contravention of these rules. Applicant's objectionable statements are set forth in full in Opposer's attached Exhibit A, which contains a copy of the body of Applicant's answer with the immaterial, argumentative statements underlined.

For example, Applicant claims as early as the second paragraph of its answer, in response to Opposer's listing of the marks that form the basis for its opposition and Opposer's statement that it owns certain of these marks through merger, that Opposer has not alleged ownership of any EXP trademark registrations or EXPRESS trademark registrations in Class 45, attaches two additional EXP trademark applications owned by Applicant, and claims that Opposer has not provided any documentation of the merger between Opposer's predecessor, Expressco, Inc., and Opposer. (Answer, ¶ 2.) These statements go far beyond a simple admission or denial to argue the merits of Opposer's claims.

Similarly, Applicant repeatedly references the pending Opposition Number 91194918 between Opposer and Applicant and claims deficiencies in Opposer's evidence, in that pending opposition, of sales revenue and advertising and marketing expenditures with regard to

Opposer's EXP Mark. (Answer, ¶¶ 8, 9, 10, 12, 22.) Applicant claims that Opposer has not provided any evidence, in the pending opposition, substantiating Opposer's claims of consumer association of the mark EXP with Opposer or of likelihood of confusion between Applicant's and Opposer's marks. (Answer, ¶¶ 17, 18, 19, 23.) These immaterial, argumentative statements are legion throughout Applicant's answer (Exhibit A), and are inappropriate in an answer.

Opposer has met the requirements for its initial pleading. In its notice of opposition, Opposer need only allege such facts that would, if proved, establish that "(1) the opposer has standing to maintain the proceeding, and (2) a valid ground exists for opposing registration." *Order of Sons of Italy in America v. Profumi Fratelli Nostra AG*, 36 U.S.P.Q.2d 1221, 1222 (T.T.A.B. 1995) (*citing Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024 (C.C.P.A. 1982)). Opposer's notice of opposition must be examined in its entirety, and the allegations therein construed liberally, as required by Fed. R. Civ. P. 8(f), to determine whether the notice contains any allegations, which, if proved, would entitle Opposer to the relief sought. *See id.*; *see also Saint-Gobain Abrasives, Inc. v. Unova Industrial Automation Systems, Inc.*, 66 U.S.P.Q.2d 1355 (T.T.A.B. 2003).

Opposer has properly pleaded its claims in its notice of opposition, which, if proven, would establish Opposer's standing and valid grounds for opposing Applicant's mark. Applicant's attacks, on the merits, against the sufficiency of the evidence and Opposer's substantiation of its claims are *expressly* to be reserved for later phases of this proceeding, and Applicant's argumentative responses should be stricken from its answer.

II. APPLICANT'S STATEMENTS THAT IT IS A "HOLDING COMPANY" ARE IMMATERIAL AND SHOULD BE STRICKEN

Applicant repeatedly refers to the fact that it is an "intellectual property holding company" in its answer. (Answer ¶¶ 25, 26, 27, 28, 29.) However, this fact is immaterial to the

claims and defenses at issue. In the related Opposition Number 91194918, the Board rejected Applicant's rationale for withholding document production, that is, because Applicant is merely a holding company and not an operating company, and its mark is used by Applicant's nonparty licensee. *Express, LLC v. EXP613, LLC*, Opposition No. 91194918 (March 3, 2012 Order at 6-7) ("It is not relevant, or a valid objection, that applicant is a 'holding company' or that its mark is used pursuant to a license.") (*citing, inter alia, Pioneer Kabushiki Kaisha v. Hitachi High Technologies*, 74 U.S.P.Q.2d 1672, 1679 (T.T.A.B. 2005)). Accordingly, Opposer requests that the Board strike any reference to and reliance on Applicant's status as an "intellectual property holding company" from Applicant's answer in the present opposition proceeding.

III. CONCLUSION

For all of the foregoing reasons, Opposer, Express, LLC, respectfully requests that the Board grant Opposer's motion to strike, and/or that the Board grant to Opposer such other and/or further relief as the Board may deem just and proper under the circumstances.

Dated: New York, New York
April 2, 2013

COLUCCI & UMANS

By: Frank J. Colucci

Frank J. Colucci
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CERTIFICATE OF SERVICE

It is hereby certified that a copy of the foregoing "OPPOSER'S MOTION TO STRIKE APPLICANT'S ANSWER" has been forwarded via First Class Mail, postage prepaid, to Applicant's attorney, C. Andrew Im, IM IP Law PLLC, P.O. Box 355, Scarsdale, New York 10583-0355 on this 2nd day of April, 2013.

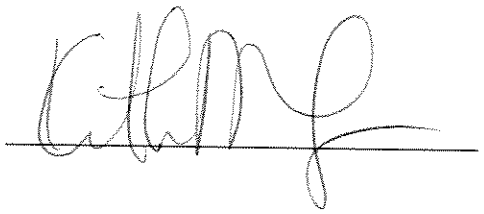

EXHIBIT A

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the matter of Trademark Application Serial No. 85/627,524
By EXP613, LLC for the mark EXP

Express, LLC,	§	
	§	
Opposer,	§	
	§	
v.	§	Opposition No. 91208967
	§	
EXP613, LLC,	§	
	§	
Applicant.	§	

ANSWER TO NOTICE OF OPPOSITION

Applicant, EXP613, LLC ("Applicant"), hereby answers the Notice of Opposition of Express, LLC ("Opposer"). Applicant reserves the right to amend or supplement this Answer to the Notice of Opposition as appropriate.

1. With respect to paragraph 1, Applicant does not have information sufficient to admit or deny the allegations and Applicant therefore denies the allegations.

2. With respect to paragraph 2, Applicant does not have information sufficient to admit or deny the allegations and Applicant therefore denies the allegations. Opposer has **not** alleged any EXP Trademark Registrations in any International Class. Opposer has **not** alleged any EXPRESS Trademark Registrations and/or Applications in International Class 45, subject international Class of Applicant's Opposed Application. Whereas, Applicant **owns** two (2) other allowed EXP Trademark Application Serial Nos. 85/627,510 and 85/482,770 in International Class 45, which are attached as Exhibit A. In the pending consolidated Opposition No. 911194918 (referenced in paragraph 13 of Opposer's Notice of Opposition), Opposer refused to provide any documents relating to the merger between Expressco, Inc. and Express, LLC.

3. With respect to paragraph 3, Applicant denies the allegations that Opposer's EXPRESS marks have priority over Applicant's EXP mark. Applicant does not have information sufficient to admit or deny the other allegations in paragraph 3 and Applicant therefore denies the allegations.

4. With respect to paragraph 4, Applicant does not have information sufficient to admit or deny the allegations and Applicant therefore denies the allegations.

5. With respect to paragraph 5, Applicant does not have information sufficient to admit or deny the allegations and Applicant therefore denies the allegations. In the pending consolidated Opposition No. 911194918 (referenced in paragraph 13 of Opposer's Notice of Opposition), although Opposer alleged that EXP is an abbreviation of EXPRESS, Opposer **did not** provide any evidence to support this claim and now re-alleges its groundless claim. Also, in the pending consolidated Opposition No. 91194918, Opposer **did not** provide evidence to support its claim that Opposer had continuously used the EXP mark after Opposer's EXP Trademark Registration 1,539,267 was canceled in 1995 for costume jewelry, watches and clocks in class 14 and canceled in 2009 for clothing in class 25.

6. With respect to paragraph 6, Applicant does not have information sufficient to admit or deny the allegations and Applicant therefore denies the allegations.

7. With respect to paragraph 7, Applicant does not have information sufficient to admit or deny the allegations and Applicant therefore denies the allegations. Opposer has **not** alleged any use of the EXPRESS nor EXP mark in International Class 45, subject International Class of Applicant's Opposed Application. Opposer's Exhibit D allegedly showing samples of Opposer's use of the EXPRESS and EXP marks in connection with Express' mobile phone application show only samples of Opposer's use of the EXPRESS mark and **no use** of the

Opposer's alleged EXP mark. Since long prior to August 20, 2010 (Opposer's alleged first use date of EXP PERK mark in International Class 9), Applicant's licensee has continuously used the EXP mark for the patented EXP Commerce System, which is the subject of U.S. Patent Nos. 7,962,374 and 8,112,319, attached hereto as Exhibit B.

8. With respect to paragraph 8, Applicant does not have information sufficient to admit or deny the allegations and Applicant therefore denies the allegations. In the pending consolidated Opposition No. 911194918, although Opposer alleged continuous use of the EXP mark on variety of goods, Opposer **refused and did not** provide any evidence of its revenue allegedly derived the sale of its alleged EXP branded goods.

9. With respect to paragraph 9, Applicant does not have information sufficient to admit or deny the allegations and Applicant therefore denies the allegations. In the pending consolidated Opposition No. 911194918, although Opposer alleged continuous use and advertisement of the EXP mark on variety of goods, Opposer refused to provide any figures or evidence it spent on advertising and/or marketing its alleged EXP branded goods.

10. With respect to paragraph 10, Applicant does not have information sufficient to admit or deny the allegations and Applicant therefore denies the allegations. In the pending consolidated Opposition No. 911194918, although Opposer alleged continuous use and advertisement of the EXP mark on variety of goods, Opposer **refused and did not** provide any figures or evidence it spent on advertising and/or marketing its alleged EXP branded goods.

11. With respect to paragraph 11, Applicant does not have information sufficient to admit or deny the allegations and Applicant therefore denies the allegations. Apparently the public, including the New York Stock Exchange, believes that EXPRESS abbreviates to EXPR and **not** EXP.

12. With respect to paragraph 12, Applicant does not have information sufficient to admit or deny the allegations and Applicant therefore denies the allegations. In the pending consolidated Opposition No. 911194918, although Opposer alleged continuous use of the EXP mark on variety of goods, Opposer **refused and did not** provide any evidence of its revenue allegedly derived the sale of its alleged EXP branded goods. Also, in the pending consolidated Opposition No. 91194918, Opposer **did not** provide any evidence that the public associates the EXP mark with the Opposer and Opposer **did not** provide any evidence of any confusion between Applicant's EXP mark and Opposer's EXPRESS mark.

13. With respect to paragraph 13, upon information and belief, Applicant admits that Opposer's EXP Trademark Registration 1,539,267 was canceled in 1995 for costume jewelry, watches and clocks in class 14 and canceled in 2009 for clothing in class 25. Applicant admits that Opposer filed oppositions against Applicant's four EXP Trademark Application Nos. 77/286,020, 77/799,392, 85/095,689 and 85/095,702 alleging but not providing any evidence that EXP is an abbreviation of EXPRESS. Applicant admits that these four oppositions were consolidated under still pending Opposition No. 91194918. Applicant denies that its EXP mark is an abbreviation of Opposer's EXRESS mark. Applicant denies that the Opposer's EXP & Design mark filed under Serial No. 77/733,938 is identical to Opposer's canceled Trademark Registration 1,539,267. Applicant does not have information sufficient to admit or deny the remaining allegations and Applicant therefore denies the allegations.

14. With respect to paragraph 14, Applicant admits that it is a single member Florida limited liability company with Mr. Andrew Altschuler as its sole member and residing in Israel. Applicant denies that it is "an importer and retailer of furniture, accessories and home décor

products." Upon information and belief, Opposer is well aware from the pending consolidated Opposition No. 911194918 that Applicant is an Intellectual Property holding company.

15. With respect to paragraph 15, Applicant admits that its adoption and use were without license, permission or authorization of Opposer, but denies the allegation to the extent that it implies or otherwise connotes that any license, permission or authorization was required.

16. With respect to paragraph 16, Applicant reasserts its responses to each previous paragraph.

17. With respect to paragraph 17, Applicant denies the allegations. In the pending consolidated Opposition No. 91194918, Opposer **did not** provide any evidence that the public associates the EXP mark with the Opposer and Opposer **did not** provide any evidence of any confusion between Applicant's EXP mark and Opposer's EXPRESS mark.

18. With respect to paragraph 18, Applicant denies that "[t]here are no restrictions on Applicant's Goods" is vague and ambiguous and therefore Applicant does not have information sufficient to admit or deny the allegation and accordingly, denies the allegations. Applicant admits that there are no restrictions on the trade channels through which its goods may be sold. Applicant does not have information sufficient to admit or deny the other allegations of paragraph 13 and Applicant therefore denies the allegations. In the pending consolidated Opposition No. 91194918, Opposer **did not** provide any evidence that the public associates the EXP mark with the Opposer and Opposer **did not** provide any evidence of any confusion between Applicant's EXP mark and Opposer's EXPRESS mark.

19. With respect to paragraph 19, Applicant denies the allegations. In the pending consolidated Opposition No. 91194918, Opposer **did not** provide any evidence that the public associates the EXP mark with the Opposer and Opposer **did not** provide any evidence of any

confusion between Applicant's EXP mark and Opposer's EXPRESS mark. In fact, Opposer has no EXP trademark registrations. Whereas, Applicant **owns** ten (10) Trademark Registrations for the EXP mark in International Classes 4, 9, 14, 16, 19, 20, 21, 24, 27, 28 and 35. Applicant **owns** ten (10) allowed Trademark Applications for the EXP mark in International Classes 16, 35, 36, 37, 39, 41, 42, 43 and 45.

Applicant's EXP Trademark Registrations

Reg. No.	Reg. Date	Mark	Appl. No.	Filing Date	Class
3,551,264	12-23-2008	EXP	77/286,062	9-21-2007	9, 14, 16, 20, 24, 27, 28
4,053,310	11-08-2011	EXP	77/286,042	9-21-2007	21
3,604,236	4-07-2009	EXP	77/976,651	9-21-2007	14
4,071,469	12-13-2011	EXP	85/095,698	7-29-2010	4
4,071,470	12-13-2011	EXP	85/095,710	7-29-2010	19
4,084,652	1-10-2012	EXP	85/095,724	7-29-2010	20
4,096,816	2-07-2012	EXP	85/095,730	7-29-2010	21
4,080,893	1-03-2012	EXP	85/095,740	7-29-2010	27
4,277,324	1-15-2013	EXP	85/613,877	5-01-2012	35
4,289,085	2-12-2013	EXP	85/668,510	7-03-2012	35

Applicant's Allowed EXP Trademark Applications

Appl. No.	Filing Date	Mark	Class	Status	Status Date
85/482,571	11-29-2011	EXP	39	Allowed	7-03-2012
85/482,646	11-29-2011	EXP	43	SOU Accepted	2-23-2013
85/482,770	11-29-2011	EXP	45	Allowed	7-31-2012
85/508,254	1-04-2012	EXP	42	Allowed	7-03-2012
85/508,275	1-04-2012	EXP	41	Allowed	7-03-2012
85/508,294	1-04-2012	EXP	36	SOU Submitted	1-20-2013
85/508,830	1-04-2012	EXP	37	Allowed	7-03-2012
85/613,884	5-01-2012	EXP	35	Allowed	11-27-2012
85/627,510	5-16-2012	EXP	45	Allowed	11-27-2012
85/658,080	6-21-2012	EXP	16, 36	Allowed	11-27-2012

True and accurate print-outs of the aforesaid registrations and allowed applications for Applicant's EXP trademarks and service marks from the United States Trademark Status & Document Retrieval (TSDR) Application are attached hereto as Exhibit A. Said registrations are valid and subsisting.

20. With respect to paragraph 20, Applicant denies the allegations.

21. With respect to paragraph 21, Applicant reasserts its responses to each previous paragraph.

22. With respect to paragraph 22, Applicant denies the allegations. In the pending consolidated Opposition No. 911194918, although Opposer alleged continuous use of the EXP

mark on variety of goods, Opposer **refused and did not** provide any evidence of its revenue allegedly derived the sale of its alleged EXP branded goods.

23. With respect to paragraph 23, Applicant denies the allegations. In the pending consolidated Opposition No. 91194918, Opposer **did not** provide any evidence that the public associates the EXP mark with the Opposer and Opposer **did not** provide any evidence of any confusion between Applicant's EXP mark and Opposer's EXPRESS mark.

24. With respect to paragraph 24, Applicant reasserts its responses to each previous paragraph.

25. With respect to paragraph 25, Applicant denies the allegation. Upon information and belief, Opposer is well aware from the pending consolidated Opposition No. 911194918 that Applicant is an Intellectual Property holding company.

26. With respect to paragraph 26, Applicant denies the allegation. Upon information and belief, Opposer is well aware from the pending consolidated Opposition No. 911194918 that Applicant is an Intellectual Property holding company.

27. With respect to paragraph 27, Applicant denies the allegation. Upon information and belief, Opposer is well aware from the pending consolidated Opposition No. 911194918 that Applicant is an Intellectual Property holding company.

28. With respect to paragraph 28, Applicant denies the allegation and corrects the following misrepresentations by Opposer, as of January 22, 2013 (the filing date of Opposer's Notice of Opposition):

- Applicant denies that it is "a furniture importer." Upon information and belief, Opposer is well aware from the pending consolidated Opposition No. 911194918 that Applicant is an Intellectual Property holding company.

- Applicant's Trademark Application No. 85/613,877 for the EXP mark in International Class 35 already issued as Trademark Registration No. 4,277,324 on January 15, 2013.
- Applicant submitted Statement of Use and accompanying specimen evidencing use in US commerce on January 3, 2012 in Applicant's Trademark Application No. 85/482,646 for the EXP mark in International Class 43, which was accepted by United States Patent and Trademark Office on February 23, 2013.
- Applicant submitted Statement of Use and accompanying specimen evidencing use in US commerce on January 20, 2013 in Applicant's Trademark Application No. 85/508,294 for the EXP mark in International Class 36.

Further, Applicant's Trademark Application No. 85/668,510 for the EXP mark in International Class 35 for retail store services issued as Trademark Registration No. 4,289,085 on February 12, 2013. Moreover, allowance of Applicant's Trademark Application No. 85/613,843 in International Class 35 was delayed by Opposer filing baseless Request to Extend the Time to Oppose by 90 days on October 23, 2012, which is attached hereto as Exhibit C. True and accurate print-outs of the aforesaid registrations and applications for Applicant's EXP trademarks and service marks from the United States Trademark Status & Document Retrieval (TSDR) Application are attached hereto as Exhibit A.

29. With respect to paragraph 29, Applicant denies the allegations. Upon information and belief, Opposer is well aware from the pending consolidated Opposition No. 911194918 that Applicant is an Intellectual Property holding company.

30. With respect to paragraph 30, applicant denies the allegations.

To the extent that Applicant has not admitted or denied any other allegation contained in Opposer's Notice of Opposition, all such allegations are hereby denied by Applicant.

AFFIRMATIVE DEFENSE

The facts set forth in Opposer's Notice of Opposition are insufficient to state a claim or to support an opposition to Applicant's Application Serial No. 85/637,524.

WHEREFORE, Applicant respectfully requests that this Opposition be dismissed, that judgment be entered in Applicant's favor, and that Applicant's application for the EXP mark proceed to allowance.

Dated: March 4, 2013

Respectfully submitted,
IM IP LAW PLLC

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Attorneys for Applicant EXP613, LLC

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the above and foregoing instrument was sent by United States First Class Mail, Postage Prepaid, on March 4, 2013 to:

Frank J. Colucci, Esq.
Colucci & Umans
218 East 50th Street
New York, NY 10022

C. Andrew Im